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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,208	02/08/2002	Patrick Bernardelli	A0000135-01-CFP	8057

7590

06/13/2003

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EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,208

Applicant(s)

BERNARDELLI, PATRICK

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Abstract

1. The abstract is defective, because it does not define clearly what the invention is. It is recommended that applicants draw the reaction to define their invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, the proviso "the inert aprotic solvent is not dichloromethane, dichloroethane or trichloro ethane" lacks descriptive support. Said proviso was not present when the case was filed originally.

3. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the oxidation of diazepam (see example 2, compound 1), does not reasonably provide enablement for the oxidation of any organic compound. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate

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in scope with these claims. There has been recited a process for the oxidation of an organic compound, but the specification is not enabled for such a scope.

There has been recited in claim 1 the oxidation of organic compounds in general, but it is not plausible to oxidize all organic compounds with a reaction medium comprising a metalloporphyrin (in general) and an oxidizing agent in an inert aprotic solvent. For example, an oxidized compound such as carboxylic acid cannot be oxidized further. Applicant's claim of oxidizing all organic compounds is the same as a doctor saying "I can treat all type of diseases with a single tablet." For example (page 9), it has been disclosed the oxidation of diazepam (1) into its oxidized product, but it did not produce a single oxidized product. The byproducts (compound 2, and compounds 4-6) are the indication that the reaction is not clean.

Applicants have also claiming metalloporphyrin (in general) as a catalyst for oxidation, but the specification does not teach the use of metalloporphyrin in general for catalytic oxidation. For example, it has been recited in (Battoni et al. Laboratoire de Chimie et Biochimie Pharmacologiques et Toxicologiques, Univ. Rene Descartes, Paris, Fr., Act. Dioxygen Homogeneous Catal. Oxid. [Proc. Int. Symp], 5th (1993), 449 that the structure of the metalloporphyrin affects the oxidation process. This indicates that some metalloporphyrin compounds are not used as a catalyst for oxidation. What type of metalloporphyrin are applicants claiming?

It is required that applicants claim to what actually are entitled to. It requires undue experimentation to find out, which organic compounds/groups (e.g. diazepam,

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azepine, alcohols, alkanes, amines, etc.) are oxidized and which are not. The same is true for the catalyst.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the phrase "organic compounds" is indefinite. What are covered and what are not? How can one tell which organic compounds are covered and which are not? It is required that applicants recite the organic compounds that are oxidized.

b. In claim 1, the term "metalloporphyrin" is indefinite. What are covered and what are not? What are the metals? Are the porphyrin substituted? If so, by what? Since the structure of the metalloporphyrins are critical for the reaction, it is recommended that applicants recite in the claim the type of the metals and the nature of porphyrin (see specification pages 3-4).

Conclusion

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624



Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1624

KH
June 11, 2003